

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN F. SPAULDING

Appeal 2006-3206
Application 09/550,276
Technology Center 1600

Decided: September 28, 2006

Before PAK, WARREN, and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2006); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

We initially note that in spite of two Orders entered by this Board on August 2, 2005 and March 7, 2006, the Examiner did not include the proper

United States patent number for Izumi in the Supplemental Answer mailed May 22, 2006 (Supplemental Answer 3 and 7).

The record shows that Appellant submitted a substituted specification and abstract with the amendment filed August 12, 2002, making certain statements with respect to 37 C.F.R. § 1.125 (2002) at page 6. The status of this document is not apparent on the record. In the final action mailed November 12, 2002, the Examiner stated “[t]he Office acknowledges receipt of the substituted specification” at page 2, which statement does not indicate whether the substitute specification complied with said rule and MPEP § 1211 (8th ed., August 2001) and has been entered in the record. Indeed, the Examiner has not stated that the document is entered (no markings to that effect are on the document) and refers to the original specification with respect to “Surmodics, Inc.” (Supplemental Answer 3 and 9).

We copy appealed independent claims 1 and 10 and representative dependent claims 11, 21, and 24 as they appear in the Claims Appendix to the Brief:

1. A cytometer apparatus comprising:

a rotating means adapted to receive and rotate a transparent cylinder along a longitudinal axis of the transparent cylinder;

a light source for illuminating at least a portion of said transparent cylinder while the transparent cylinder is being rotated by the rotating means;

a detector for detecting a light signal provided by said light source and reflected from said transparent cylinder while the transparent cylinder is being rotated by the rotating means;

determining means for determining at least one cytometric characteristic of a sample disposed in said transparent cylinder based on said light signal; and

a movement means for moving said transparent cylinder and said light source and detector in a longitudinal axis relative to one another.

10. A spin cytometer apparatus comprising:

a rotating means for rotating a transparent cylinder about a longitudinal axis of the transparent cylinder;

a light source for illuminating at least a portion of the transparent cylinder while the transparent cylinder is being rotated by the rotating means;

a detector means for detecting a light signal generated by the light source and reflected from the transparent cylinder while the transparent cylinder is being rotated by the rotating means;

determining means for determining at least one cytometric characteristic of a sample disposed in said transparent cylinder based on said detected light signal; and

a movement means for moving the transparent cylinder and the light source and detector means in relative motion.

11. The spin cytometer of claim 10, wherein the rotating means is adapted to sequentially rotate a transparent cylinder in two (2) directions.

21. The spin cytometer of claim 10, wherein the rotating means comprises a stepper motor.

24. The spin cytometer of claim 10, wherein the detector means further comprises an analog to digital converter.

It is readily apparent that all of the appealed claims include in substantial part elements that are stated in terms of “means,” “means comprises,” “means further comprises,” and “means . . . adapted” coupled with a recitation of the function to be performed by such “means.” The resolution of the principal issues in the grounds of rejection under 35 U.S.C. §§ 102(b) and 103(a) advanced on appeal requires that the subject claim language must first be interpreted by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in

appellants' specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.”); *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*in banc*) (“[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).”).

In view of the “means” recitations which specify the function but do not define structure which satisfies that function in the appealed claims, the strictures of 35 U. S. C. § 112, sixth paragraph, apply. *See Texas Digital Systems, Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited therein. Therefore, all of the “means” language in the appealed claims must be construed as limited to the “corresponding structure” disclosed in the written description in the

specification and “equivalents” thereof. *Donaldson*, 16 F.3d at 1192-95, 29 USPQ2d at 1848-50.

The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “‘the specification . . . clearly links or associates that structure to the function recited in the claims.’ [Citation omitted.]” *Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six,” and in this respect, the examiner should not confuse “impermissibly imputing limitations from the specification into a claim with properly referring to the specification to determine the meaning of a particular word or phrase in a claim. [Citations omitted.]” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *see also Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1028 (explaining *Donaldson*).

Thus, the Examiner must first interpret the “means for” claim language as well as the effect thereon of the terms “adapted,” “comprising,” and “further comprising” in order to establish a *prima facie* case of

anticipation and of obviousness over the applied prior art because all of the claim limitations must be considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection “*every* limitation in the claim must be given effect rather than considering one in isolation from the others.”); *cf. Donaldson*, 16 F.3d at 1195-97, 29 USPQ2d at 1850-52.

Here, the Examiner has not interpreted the “means” language in the appealed claims with respect to the “corresponding structure” in the specification and “equivalents” thereof in a manner consistent with the requirements of 35 U. S. C. § 112, sixth paragraph, and indeed, has suggested “means” language to Appellant without such findings (Supplemental Answer in entirety).

We further have considered the disclosure with respect to “Surmodics, Inc.” in the specification (original specification 5:17) as cited by the Examiner (Supplemental Answer 9). The actual process performed by this commercial entity with respect to “[t]he inner wall of the cylinder is modified for photo cross-linking by SurModics, Inc. Eden Prairie, MN” are not apparent from this disclosure (original specification 5:17-22). It is further has not been established on the record whether the process was known and thus prior art to Appellant under 35 U.S.C. § 102(a) (2002).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to (1) supply the correct citation for Izumi; (2) establish on the record whether the substitute specification and abstract with the amendment filed August 12, 2002 have been entered; (3) interpret the “means” limitations of the appealed claims by first

determining the “corresponding structure” for the “function” in the limitation that is described in the specification, and then determining whether the corresponding structure or “equivalents” thereof are taught or suggested by the applied prior art,¹ in a manner consistent with the requirements of 35 U. S. C. § 112, sixth paragraph, in order to determine whether the references are applicable to the interpreted claims under § 102(b) and/or § 103(a), and if so, setting forth the interpretation, findings, and determinations in a Supplemental Examiner’s Answer; and (4) establish on the record the process performed by SurModics, Inc. and whether this process is prior art to Appellant, under with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This Remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. § 41.50(a)(2) (2006), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

¹ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

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We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 3, August 2005).

REMANDED

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